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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,041

Applicant(s)

HELT, DAVID J.

Examiner

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 5.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1 - 16 are presented for examination.

#### ***Drawings***

2. The drawings are objected to because there is a mistyping – “andd” at step 702, Fig. 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification. Also, It is noted that the present specification does not contain line numbers. For ease of reference by both Examiner and Applicant all future correspondence should include the recommended line numbering.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 11, is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claim 11, applicant fails to disclose the mechanism of a file importation program to convert and create the claimed legacy files to various claimed portions with various claimed formats. As such, it is not enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (Based on Fig. 2 and Fig. 6, the claimed functions are done by the file extraction program, not the claimed file importation program).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 11, it is unclear what does the claimed first format file server refer to [i.e., Does it refer to the Current Format File Server? Or the Legacy File Server or others (please see Fig. 1)]. Furthermore, it is uncertain which server performs which function as claimed by the Applicant.

As to claim 6, it is unclear where does the claimed conversion verification program reside [i.e., it is in the file verification server, or the claimed file extraction server, or others?]. The term "The file extraction server" lack of antecedent basis.

As to claims 2-5, 7-11 and 12-16, these claims have the same defect as their base claims, hence are rejected for the same reason.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Day, III et al. (U.S. Patent No. 6,185,580), in view of Crawford (U.S. Patent No. 6,411,943).

As to claims 1, 6 and 12, Day, III et al. (hereinafter referred as Day) discloses a system with means, method and computer program product, for converting a plurality of data files and associated information from a first file format to a second file format [e.g. see Fig. 1; col. 1, lines 25-31], comprising:

- a) a legacy file server for storing a plurality of legacy data files in a first file format [e.g. see Fig. 2, wherein the legacy server (212) coupled to the disk controller (220) to store data files into a plurality of storage devices (e.g. 230, 232, 234)];
- b) a file extraction program [e.g., the virtual file system emulating program of the intermediary controller (250), Fig. 2; col. 2, lines 9-16] for retrieving the legacy data files, indexing, and work history information from the legacy file server [col. 2, lines 9-16; col. 4, lines 12-13, lines 21-26; lines 53-55; Fig(s). 5-6];
- c) the file extraction program [e.g., the physical information and extension (PIE) file of the intermediary controller (250), Fig. 2] further operating to convert the legacy data files and related information into data files meeting a current selected format [col. 2, lines 10-16; lines 20-33; col. 6, lines 19-27; Fig(s). 5-6].

Day discloses using a disk array controller to check for the hit of a requested data block [col. 1, lines 27-29], Day did not expressly teach: 1) applying a verification

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program for ensuring that the conversion made by a file extraction server; 2) a file importation program to import the newly converted data files into a format file server.

However, Crawford discloses: 1) applying a verification program [e.g. the Boot Customer Computer program(502), Fig. 10], for ensuring that the conversion made by a file extraction server is completed without error [e.g. see col. 32, lines 3-9; Fig(s). 10-11]; 2) an importing program [e.g., the communication software, col. 17, line 51; or the communication link module (150), Fig. 5] to load the newly converted data files into a format file server [col. 17, lines 47-66; the Replica Server Router Control (480), Fig. 9]. Thus, It would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to combine the teachings of Day and Crawford, by adding a verification program and communication software as taught by Crawford in Day's disk controller, because by doing so, the system is allowed to check the completion of the data file as it go through the conversion processing made by the file extraction server (or the replica server) and thus, import/export the converted files as online service control data to a desired format file server [e.g., see the steps 502-504, Fig. 10] via the communication software as suggested by Crawford.

As to claims 2-5, 7 and 13-16, Day and Crawford teach all the features as claimed, Crawford further disclose that the file extraction program (i.e. the local disk access program, the Remote Disk access Program, Fig. 6E) is resident on a file extraction server [i.e., the online Service Replica Server (160), Fig. 6E] operatively

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connected to the legacy file server [e.g., the online Service Host computer system (104), Fig. 6E]. wherein, the file extraction server [e.g., the Replica Computer (160), Fig. 3] comprising the following functions:

- a) receiving a listing of files to be converted from one format to second format via the communication link [150, Fig. 3; steps 404-406, Fig. 8A];
- b) determining an accuracy of the second format data file, if it is not accurate than generating an error message [col. 37, lines 4-9];
- c) creating a virtual disk to include indexing information [col. 6, lines 6-16; col. 19, lines 17-25; lines 29-34];
- d) converting media and document from first format to second format by using a replica [col. 10, lines 9-12].

As to claims 8-10, Day and Crawford teach all the features as claimed, Crawford further disclose that the conversion verification program [e.g. the Security module of the Customer Computer System(50), Fig. 6E] is resident on a conversion verification server [e.g. the Customer Computer System(50), Fig. 6E] operatively connected to the legacy file server [e.g., the online Service Host computer system (104), Fig. 6E] and the file extraction server [i.e., the online Service Replica Server (160), Fig. 6E] via a network [e.g., col. 4, lines 34-54; the LAN(82), the Communication Controllers (112a), Fig. 4].

### ***Conclusion***



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7. To expedite the process of examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are: Carothers et al. ( U.S. Patent No. 6,587,857) which disclosed a system for integrating operational data received from network prior to loading the data onto a data warehouse for sharing.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-6296.

Susan Chen

August 5, 2003

  
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